

**REMARKS**

The Examiner raised a question about the priority claims. The Amendment to the Specification has been made. Please note that there are four claims to priority being made and only three have been reflected on the filing receipt.

The Examiner next objected to applicant's Information disclosure statement. Please note that the IDS filed December 28, 2004 was submitted with the four foreign patent references cited. Enclosed is a copy of the stamped Return Receipt Postcard listing these enclosures. Further, the Applicant respectfully points out that these references are included in the Image File Wrapper for this application. Further, the Applicant requests the Examiner to consider all Foreign Patents and Non-Patent Literature cited in the Information Disclosure Statement filed December 15, 2003. Copies of the references cited were not required to be provided in accordance with 37 C.F.R. § 1.98(d) since all of the patents listed and Non-patent literature have been previously cited or submitted in US Patent 6,854,462; 6,588,422; and 10/915,080, now allowed, which this application claims priority pursuant to 35 U.S.C. § 120 and 37 C.F.R. § 1.98(d). In addition, copies of the non-US patents cited are being submitted with this communication.

With respect to the claim formality objections raised by the Examiner, claim 44 is being amended by adding the word "rate" before the word "determining." Claim 49 is being cancelled.

Claims 39, 45 and 50 were rejected as being obvious in view of Biondi et al. Patent No. 5,377,671. But Biondo et al. has little to do with the subject invention. In Biondi et al., pressure in the lungs is increased and decreased in step with the two phases of a heartbeat in order to assist the heart. In the subject invention, oscillations at the heartbeat rate in a patient's air flow are used to determine whether the patient's airway is open. These are two totally different things. The claims in issue all define analyzing air flow to see if there is a cardiogenic component in order to determine if the airway is open or closed. The claims have absolutely no application to Biondi et al.

Regarding claim 39, the Examiner recognizes that Biondi et al. does not teach determining airway patency by detecting the presence of cardiogenic air flow. However, the Examiner argues that the device of Biondi et al. is capable of performing the analysis – the EKG could be used to detect the presence of cardiogenic air flow, and

pressure could be increased based on the analysis. Applicant could cite a hundred other references which could practice different pieces of the claimed invention, but that is not the same thing as putting them all together and doing it. What the Examiner's rejection boils down to is that "it would have been obvious" to use applicant's method to determine what sleep apnea treatment to apply. But without the citation of any prior art that would make it obvious, the rejection is improper.

The closest the Examiner comes to citing relevant prior art is Watson Patent No. 4,777,962. But Watson does not teach using cardiogenic oscillations to detect airway patency. Just the opposite – in column 6, lines 25-32, Watson says to "exclude cardiogenic oscillations."

The Examiner uses a similar argument with respect to claim 45. Again, it is admitted that Biondi et al. does not teach the invention. But the Examiner says that the reference device could be programmed to perform the invention. By that logic, practically every invention that uses a personal computer should not be patentable because the computer could be programmed to do the claimed job. This has never been a proper ground of rejection because, were it a proper ground, practically no digital system would ever be patentable.

The same kind of rejection was used by the Examiner for claim 50, and applicant repeats that it is not enough to argue that the invention was obvious without any support being given.

Claims 40-44, 46-49 and 51-54 were rejected as being unpatentable over Biondi et al. and Rapoport Patent No. 5,335,654. Rapoport teaches CPAP treatment and detection of flow limitation to control the applied pressure. But the Examiner admits that Rapoport also does not teach cardiogenic air flow as an indication of flow limitation.


To turn Rapoport into an acceptable reference, the Examiner argues that Rapoport says that techniques other than those he disclosed could be used to detect an air flow limitation. But the specific technique of detecting a cardiogenic component is a feature of applicant's invention, it was not disclosed by Rapoport, and that Rapoport could have used it had he known about it is not the same thing as Rapoport having taught it. Once again, the Examiner is relying on what he says "was known in the art" without providing any support for the argument.

Similar remarks apply to the specific dependent claims. For example, with respect to claim 42 the examiner admits that Rapaport does not teach a filter specifically, yet somehow Rapaport is used as the prior art that teaches the feature because "it would have been obvious" to use a filter. The same improper logic is used in connection with the Fourier Transform feature of claim 43 – Rapaport does not have it, but it would have been obvious. One wonders why Rapaport was even cited.

The Examiner uses the two other references against two of the other claims, but these are dependent claims and even the Examiner does not contend that these references disclose the elements missing from Biondi et al., Watson and Rapaport.

It is believed that all of claims 39-48 and 50-54 are allowable over the art of record, and further consideration of these claims and the passage to issue of the application are respectfully requested.

Respectfully submitted,  
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